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In re Application of :
MARKOWITZ, Sanford :
Serial No.: 10/649,591 :Decision on Petition
Filed : August 26, 2003 :
Attorney Docket No.: CWRU-P03-003 :

This letter is in response to the Petition under 37 C.F.R. 1.144 filed on May 25, 2007 requesting reconsideration of the restriction requirement.

BACKGROUND

On May 3, 2006, the examiner mailed a restriction requirement in which the original claims 75-122 were divided into 6 groups and a specific sequence for an election of species was required.

On June 9, 2006, Applicants elected Group I (Claims 75-107) drawn to a method of detecting a polypeptide having SEQ ID No 3 with traverse. The response traverses the election of species requirement asserting the search of the polypeptide having SEQ ID NO: 3 and the polypeptide having SEQ ID No 21 would not constitute a burden. Applicant elected a method of detecting a polypeptide having SEQ ID NO: 3.

On July 6, 2006 the examiner considered the traversal, made the restriction requirement final and mailed to applicants a non-final Office action, in which Group I (Claims 75, 84-91, 93, 95-106) and a method of detecting a polypeptide having SEQ ID NO: 3 were searched and examined on the merits. The examiner withdrew Claims 94 and 123 drawn to a method of detecting a polypeptide encoded by the polynucleotide having SEQ ID NO: 5 and a method of detecting a polypeptide having SEQ ID No 21 respectively.

On November 13, 2006, Applicants file a response to the Office action.

On December 19, 2006, the examiner considered the response and mailed a final Office action.

On February 21, 2007, Applicants filed an after final amendment.

On March 20, 2007, the Applicants and the examiner held a telephonic interview to propose an examiner's amendment, however no agreement was reached and the examiner mailed an Advisory action.

On May 25, 2007, applicants filed this petition to request that the Office reconsider the restriction requirement.

DISCUSSION

The petition and file history have been carefully considered. The petition requests rejoinder of a method of detecting a polypeptide having SEQ ID NO: 21 and a method of detecting a polypeptide encoded by the polynucleotide having SEQ ID No 5 with the elected invention, a method of detecting a polypeptide having SEQ ID NO: 3.

The petition argues that the simultaneous search and examination with respect to SEQ ID NO: 3 and 21 would not impose a serious burden. The petition argues that the amino acid sequence of SEQ ID NO: 21 is a portion of SEQ ID NO: 3. An alignment of SEQ ID NO: 3 and SEQ ID NO: 21 is presented below. It is noted SEQ ID NO: 21 is embedded completely within SEQ ID NO: 3 or stated differently, SEQ ID NO: 21 is a fragment of SEQ ID NO: 3.

Applicants also request rejoinder of a method of detecting a polypeptide encoded by a polynucleotide having SEQ ID No 5. It is noted that SEQ ID NO: 5 is a nucleic acid sequence which encodes the polypeptide having SEQ ID NO: 3.

Thus, a secreted polypeptide having the amino acid sequence of SEQ ID NO: 3 encompasses a secreted polypeptide produced by the expression of the nucleic acid having the sequence of SEQ ID NO: 5.

A polypeptide having SEQ ID NO: 3, a polypeptide having SEQ ID No 21 and a polypeptide encoded by SEQ ID NO: 5 do appear to be overlapping in scope, and would not constitute independent and distinct inventions. The inventions merely differ in breadth of definition.

Combining the method of detecting a polypeptide having SEQ ID NO: 3, the method of detecting a polypeptide having SEQ ID NO: 21 and the method of detecting a polypeptide encoded by a polynucleotide having SEQ ID NO: 5 into the same group as proposed by applicant is persuasive as the sequences are overlapping and within the scope of each other. A search and examination of the method of detecting these overlapping sequences would not create a serious burden in this particular application.

The examiner, in a telephonic interview of March 16, 2007 appears to have indicated that claims limited to the method of detecting a polypeptide having SEQ ID NO: 3 would be in condition for allowance. As discussed above, a polypeptide encoded by SEQ ID NO: 5 is narrower in scope than SEQ ID NO: 3 and thus is rejoined. Furthermore, Claim 123 depends on Claim 75, and thus further limits Claim 75. Moreover, as illustrated above, SEQ ID NO: 21 is a fragment of SEQ ID NO: 3 and is not distinct from SEQ ID NO: 3.

DECISION

The petition is **GRANTED** for the reasons set forth above.


The request to withdraw the restriction requirement between the method of detecting a polypeptide having SEQ ID NO: 3, the method of detecting a polypeptide having SEQ ID NO: 21 and the method of detecting a polypeptide encoded by a polynucleotide having SEQ ID NO: 5 has been granted.

Claims 75, 84-91, 93-102, 104-106, 123-125 are under examination. The method of detecting a polypeptide having SEQ ID NO: 21 and the method of detecting a polypeptide encoded by a polynucleotide having SEQ ID NO: 5 are rejoined with the method of detecting a polypeptide having SEQ ID NO: 3 already under examination, and said methods will be examined together.

The application will be forwarded to the examiner for

- (I) further action consistent with this decision and**
- (II) consideration of the papers filed on 25 May 2007 and**
- (III) preparation of a new non-final action which also addresses the method of detecting a polypeptide having SEQ ID NO: 21 and the method of detecting a polypeptide encoded by a polynucleotide having SEQ ID NO: 5.**

Should there be any questions about this decision, please contact Special Program Examiner Julie Burke, by letter addressed to Director, Technology Center 1600, at the address listed above, or by telephone at 571-272-1600 or by facsimile sent to the general Office facsimile number, 571-273-8300.



John LeGuyader
Director, Technology Center 1600

jb/jg